

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. **10/532,202**
Applicant(s): **STEFFEN HASENZAHN, ET AL.**
Filed: **April 14, 2005**
TC/A.U. **1796**
Examiner: **Peter F. Godenschwager**
Title: **PULVERULENT MATERIALS**

Confirmation No.: **6755**

Docket No.: **032301.415**
Customer No.: **25461**

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

In response to the Final Official Action of September 21, 2009, applicants respectfully request reconsideration of this application.

Status of the Claims is reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 4 of this paper.

Attachments: Declaration of Dr. Jürgen Meyer dated Nov. 23, 2009

Listing of Claims:

Please amend the claims as follows:

1. (Previously Presented) Pulverulent materials and mixtures thereof, comprising one or more surface-modified and structure-modified pyrogenically prepared metalloid or metallic oxides wherein the surface-modified and structure-modified pyrogenically prepared metalloid or metallic oxide is

a silanized structure-modified silica having alkylsilyl groups which are octylsilyl and/or hexadecylsilyl attached to said silica, and having the following physiochemical properties:

BET surface area	25-400 m ² /g
Average primary particle size	5-50 nm
pH value	3-10
Carbon content	0.1-25% .

2. (Previously Presented) Method of improving the flowability of pulverulent materials and mixtures thereof, comprising adding to the pulverulent materials and mixtures thereof one or more surface-modified and structure-modified pyrogenically prepared metalloid or metallic oxides wherein the surface-modified and structure-modified pyrogenically prepared metalloid or metallic oxide is

a silanized structure-modified silica having alkylsilyl groups which are octylsilyl and/or hexadecylsilyl attached to said silica, and having the following physiochemical properties:

BET surface area	25-400 m ² /g
Average primary particle size	5-50 nm
pH value	3-10
Carbon content	0.1-25%.

3. (Cancelled)

4. (Previously Presented) A composition of matter comprising at least one pulverulent material which is a fire-extinguishing powder and at least one surface-modified pyrogenically prepared metalloid or metallic oxide wherein the surface-modified and structure-modified pyrogenically prepared metalloid or metallic oxide is

a silanized structure-modified silica having alkylsilyl groups which are octylsilyl and/or hexadecylsilyl attached to said silica, and having the following physiochemical properties:

BET surface area	25-400 m ² /g
Average primary particle size	5-50 nm
pH value	3-10
Carbon content	0.1-25%.

5.-14. (Cancelled)

REMARKS/ARGUMENTS

Reconsideration is respectfully requested of the Official Action of September 21, 2009, relating to the above-identified application.

The claims in the case are Claims 1, 2 and 4.

The rejection of Claim 1 as allegedly anticipated under 35 U.S.C. § 102(b) in view of the European patent of *Ettlinger, et al.* (EP 0672731), is traversed and reconsideration is respectfully requested. The European patent of *Ettlinger* is owned by the same assignee as in the present application.

The Official Action takes the position that the European patent of *Ettlinger* anticipates the claimed subject matter. However, applicants wish to point out that the claims of the present application require that the silanized structure modified silica is structurally modified. No structural modification is shown in the *Ettlinger* European patent.

To further substantiate and establish this fact, filed herewith is a Declaration by Jürgen Meyer, one of the co-inventors named in this application and who is also an inventor named in the European patent as shown by the first page of same attached hereto. Dr. Meyer clearly states on page 2 of the enclosed Declaration, after establishing that he is completely familiar and knowledgeable with respect to the content of the European patent as well as the above-identified application, that the subject matter of the European patent "...did not relate to a structurally modified silica and does not disclose a structurally modified silica and does not contemplate a composition containing a structurally-modified silica".

Dr. Meyer clearly states that the conclusion in the Official Action as to the European patent disclosing a structurally modified silica is technically incorrect and is in error.

It should also be noted that the *Ettlinger* patent was identified in the Information Disclosure Statement filed on April 13, 2005, and was considered by the Examiner more than two years ago as indicated in the Official Action of October 2, 2007. Applicants have therefore

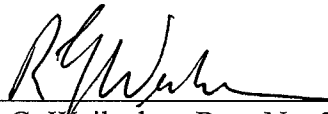
been prejudiced because two years have now elapsed in the term of any patent which may ultimately issue in this case. Applicants request that the rejection be withdrawn and that the application be immediately allowed.

For the same reasons, applicants traverse the rejection of Claim 4 under 35 U.S.C. § 103(a) as unpatentable over *Ettlinger*, European Patent 0672731, further in view of *Koehlert*, US 5,928,723. The fact remains that neither of the references show a structurally modified silica product and consequently, the rejection does not establish *prima facie* obviousness of the claimed invention.

Prompt action at the Examiner's earliest convenience is respectfully requested.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By: 
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MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
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DECLARATION UNDER 37 C.F.R. § 1.132

Jürgen Meyer, a co-inventor in the above-identified application hereby declares and states as follows:

As a co-inventor in this application, he is completely familiar with the subject matter of this application and is informed that a final rejection has issued from the U.S. Patent and Trademark Office which has rejected the claims in the application as anticipated by the European patent EP 0672731 of *Ettinger, et al.*

He wishes to call to the attention of the Examiner in the U.S. Patent and Trademark Office that he is also co-inventor named in the European patent 0672731, as shown by the attached first page of that document. He is the same Dr. Jürgen Meyer as identified under the designation "Erfinder" which is the German word meaning "inventor".

He notes that the claims in the above-identified application are directed to pulverulent materials and mixes thereof containing one or more surface-modified and structure-modified pyrogenically prepared metalloids or metallic oxides such as silica.

App. 10/532,202
Declaration

He is advised that the Official Action refers to the European patent of *Ettlinger, et al.* as disclosing a structurally-modified silica.

As the co-inventor in the European patent 0672731 which is cited in the U.S. Patent and Trademark Office against this application, he is completely familiar and knowledgeable with respect to the content of the European patent, as well as the above-identified application having been intimately involved with the invention described in each of those documents.

He can state without any qualifications whatsoever that the European patent EP 0672731 of which he is the co-inventor did not relate to a structurally modified silica and does not disclose a structurally modified silica and does not contemplate a composition containing a structurally-modified silica. Accordingly, he is of the opinion that the Official Action wherein the U.S. Patent and Trademark Office takes the position that the European patent of *Ettlinger et al.* discloses a structurally modified silica is technically incorrect and is in error.

I, Jürgen Meyer, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Date:

23/6 Nov. 2009





JÜRGEN MEYER

LIT\1086600.1




Silanised silicas

Patent number: EP0672731
Publication date: 1995-09-20
Inventor: ETTLINGER MANFRED DR (DE); KERNER DIETER DR (DE); MEYER JUERGEN DR (DE)
Applicant: DEGUSSA (DE)
Classification:
- international: C09C1/30
- european: A61K7/48A4; B01J2/30; C09C1/30D12; G03G9/097B3
Application number: EP19940118099 19941117
Priority number(s): DE19944402370 19940127

Also published as:

 JP7232912 (A)
 DE4402370 (A1)
 EP0672731 (B1)

Cited documents:

 EP0216047
 EP0475132
 JP63043976

Abstract of EP0672731

Silanised, pyrogenically-produced silica is new. Also claimed is prodn. of the silica where silanisation is effected by intensive mixing of pyrogenically-produced silica while spraying (opt. first with ester) with an alkoxy silane of formula $(RO)_3 SiCH_2H_{2n+1}$ ($R = \text{alkyl}$ and $n = 10-18$); followed by post mixing for 15-30 mins. and tempering at 100-160 deg C for 1-3 hrs.

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